

REMARKS:

Claims 1-10 are pending in the application. In the Office Action dated August 12, 2005, the Examiner rejected all pending claims under 35 U.S.C. 102(b) as being anticipated by either the Great Britain Patent (GB 2,275,768 A) or the German Patent (DE 4021460 A1), and further rejected claims 3, 7, and 10 for containing arbitrary numerical limitations. These rejections are respectfully traversed.

The Great Britain Patent does not teach an air intake duct comprising an air exhaust port and a cuttable groove formed at an external wall of the port for inserting an air filter into the air intake duct through a hole formed by cutting out the groove. The Examiner did not refer to a particular element of the Great Britain invention as teaching a cuttable groove but mentioned Figs. 1 and 2 and the descriptions thereof in the specification. In the present invention, an air filter is inserted through a hole formed by cutting out the cuttable groove 13, whereas in the Great Britain patent, an air filter is inserted via a hingedly closable opening (see abstract and page 2, paragraph 2). Specifically, in the reference, restrictor plate 17 pivots about hinge 171 between an inoperative or open position, shown in full lines in Fig. 1, when the air filter 12 is inserted, and an operative or closed position, shown in broken lines in Fig. 1, when the air filter 12 is removed. Restrictor plate 17 merely pivots in response to the insertion or removal of air filter 12 and is not removable. In contrast, claims 1 and 5 of the instant application contain the limitations that an air filter is inserted through a hole which is formed in the wall when the groove is cut, and claim 9 contains the limitation that the inner wall portion defines an opening when removed, into which the air filter is inserted. These claims inherently state that there is a removable portion of the wall whose perimeter is defined by the groove.

The Great Britain patent, however, whose air filter is inserted via a hingedly closable opening, does not disclose any removable element, nor does it disclose a cuttable groove. Therefore the Great Britain patent does not teach a cuttable groove for inserting an air filter through a hole formed by cutting out the groove, which language is in claim 1, nor does it disclose a groove configured for insertion of an air filter upon cutting out the bottom of the groove to form a hole, which language is in claim 5, nor does it disclose an inner wall portion surrounded by a peripheral groove, wherein the inner wall portion is configured and dimensioned to define an opening when removed that is adapted to receive an air filter, which language is in claim 9. For at least these reasons, all three independent claims, and the dependents thereof, are patentable over the Great Britain reference.

The German reference does not disclose an air intake comprising a port with a cross-section of a rectangular shape and a cuttable groove formed on the wall of the port for inserting an air filter into the air intake duct through a hole formed by cutting out the groove. The element 7, which the Examiner referred to as a cuttable groove, appears to be either a lid or a surface thereof (see figs. 2 and 3). The hole in the German application is not formed by cutting out a groove. Hole 10 is covered by lid 7, but it is not created by the removal of lid 7. The hole of the instant application is created when groove 13 is cut. If groove 13 is not cut, however, the hole never comes into being; the wall maintains constructural rigidity (paragraphs [0016]-[0017]). That is, the rectangular portion of the wall whose perimeter is defined by the cuttable groove 13 is either removed, forming a hole, or left in place, leaving an integrally formed wall. There is no removable cover for repeated placement on the hole. In contrast, in the German application, hole 10 already exists and it is merely covered and uncovered by lid 7. Even when lid 7 is temporarily held in place by slideable clamp 14, it does not form an integrally connected wall; hole 10 still exists beneath it.

The German patent neither discloses nor suggests hole 10 being formed by cutting a portion of the wall, nor does it suggest a cuttable groove. Therefore it does not anticipate a cuttable groove for inserting an air filter through a hole formed by cutting out the groove, which language is in claim 1, nor does it disclose a groove configured for insertion of an air filter upon cutting out the bottom of the groove to form a hole, which language is in claim 5, nor does it disclose an inner wall portion surrounded by a peripheral groove, wherein the inner wall portion is configured and dimensioned to define an opening when removed that is adapted to receive an air filter, which language is in claim 9. For at least these reasons, all three independent claims, and the dependents thereof, are patentable over the German reference.

Regarding the rejection of the recitation “the cuttable groove is dug $\frac{3}{4}$ in relation to the wall thickness” of claims 3, 7, and 10, see paragraph [0016] of the instant specification for disclosure of the critical nature of these requirements. If the cuttable groove is too shallow, cutting of the groove for insertion of an air filter becomes too difficult; that is, a groove that is too shallow is not cuttable. If the groove is too deep, air leaks may be created in cases in which the groove is not cut. Preventing air leakage in vehicles without air filters is an important object of the present invention (see at least paragraph [005] lines 3-4, paragraph [0017] lines 3-5, and paragraph [0020] line 5). The groove must be of sufficient depth for the present invention to be used in vehicles with or without air filters (see at least paragraph [005] lines 1-3 and paragraphs [0017]-[0020]). Therefore the limitation “the

cuttable groove is dug $\frac{3}{4}$ in relation to the wall thickness" precisely defines one embodiment of the present invention, and is included in the claim language to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention, as set forth in 35 U.S.C. 112, second paragraph.

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance is respectfully requested.

Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (matter no. 060945-0132)

Respectfully submitted,



Jessica C. Stahnke (Reg. No. 57,570)

for

Thomas D. Kohler (Reg. No. 32,797)

MORGAN, LEWIS & BOCKIUS LLP

One Market, Spear Street Tower

San Francisco, CA 94105

415.442.1000

November 11, 2005

Date